

REMARKS

In the Office Action mailed on May 27, 2003, claims 1-4, 6, 8-10, and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Whiting et al. (U.S. Patent No. 5,016,009) ("Whiting") in view of Okada (U.S. Patent No. 5,889,481) ("Okada") and Murashita (U.S. Patent No. 6,330,574) ("Murashita"); and claims 5, 7, and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Whiting, Okada, and Murashita in view of Aoyama (U.S. Patent No. 5,590,258) ("Aoyama"). The foregoing rejections are respectfully traversed.

Claims 1-16 are pending in the subject application, of which claims 1, 10, 14, and 15 are independent claims.

Entry of Amendment After Final Rejection:

The Applicant respectfully asserts that the amendments presented herein require only a cursory review by the examiner, and respectfully requests that the examiner enter such amendments.

Amendments to the Claims:

Claims 1, 10, 14, and 15 are amended and claim 4 is canceled herein. The features of claim 4 are incorporated into claims 1, 10, 14, and 15, as applicable. In addition, claims 5-8 and 11-13 are amended herein to delete the word "for" in several instances. Care has been exercised to avoid the introduction of new matter.

Rejections of the Claims:

Differences Between The Claimed Invention And The Cited References:

Murashita discusses creating a tag code table for compression from the DTD of the structured document. A tag code is obtained with reference to the tag code table by the tags included in the character train. The tag is replaced by the tag code, thereby achieving compression. At the same time, the portion of the character train is also coded. Thus, the code stream that is outputted is a single stream in which the tag code and the character code are mixed in the stream.

In contrast, as recited in independent claims 1, 10, 14, and 15, the two streams of the tag information stream and the tag information replaced code stream are separately created, switched, and outputted. Specifically, claim 1 of the subject application (as amended herein) recites "a code switching unit alternately separating the tag information stream stored in the tag information storing unit and the code stream stored in the code storing unit and outputting the separated stream." Claim 10 of the subject application (as amended herein) recites "a tag information separating unit separating the tag information stream and the code data stream from the code stream; [and] a character train reconstructing unit reconstructing the character train data including the character train and the tag code from the code data stream and, thereafter, replacing the tag code by the tag information stream stored in the tag information storing unit." Claims 14 and 15 of the subject application (as amended herein) recite "alternately separating the tag information stream and the code stream and outputting the separated stream."

In the claimed invention, the tag code table for compression is created from the DTD of the structured document, and is not used. The tag is separated from the input stream and the tag information stream containing only the tags is created. A tag code (the same code or order code) showing that the tag has been extracted is inputted into the portion where the tag of the input stream has been extracted, and the stream is outputted as a tag replaced character train stream. The tag replaced character train stream is coded and outputted. Therefore, two streams of the tag information stream of only the tags and the tag information stream are separately outputted. The tag information stream is not compressed, but instead transmitted as raw data.

By transmitting the tag replaced character train stream separately from the character train in which only the tag was separated from the structured document, the following benefits are obtained: the separated tag information is searched by using the tag serving as a keyword. If the coincident tag information can be searched, the tag code indicative of the separating position in the reconstructed document body is skipped by the number of codes of up to the tag information, so that it is possible to easily reach the head of the target document sandwiched by the tags. Therefore, a high-speed search can be accomplished.

Lack Of Motivation To Combine The References:

In addition, the examiner has not set forth the requisite motivation to combine the

references. Specifically, MPEP § 706.02(j) sets forth the contents of a rejection under § 103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure" (emphasis in original).

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The examiner has not sufficiently set forth the motivation to combine Murashita and Whiting. Specifically, on page 5 of the Office Action, the examiner states only that "it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Whiting and Murashita, Murashita explicitly pointed out the benefit of compressing the tags of a structured document by teaching that it 'improve[s] a compression rate of a tag document.'" (citing col. 3, line 8 of Murashita) (errors in original) However, someone skilled in the art would not have been motivated to combine Murashita and Whiting at the time the invention was made because Whiting discusses adding a 'zero' bit to uncompressed data and a 'one' bit to compressed data, while Murashita discusses coding all of the data. Clearly, the two inventions cannot be reconciled, nor has the examiner offered any explanation other than a short statement

of the benefit of Murashita (citing col. 3, line 8 of Murashita).

Conclusion:

Therefore, independent claims 1, 10, 14, and 15 of the subject application (as amended herein) are patentably distinguishable over the cited references. In addition, dependent claims 2-3, 5-9, 11-13, and 16 are allowable based in part on their dependency, directly or indirectly, from one of allowable claims 1, 10, 14, and 15.

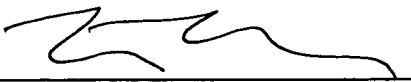
Withdrawal of the foregoing rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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